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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,673	08/19/1999	MASAYUKI YAMANA	20-4594P	6781

7590

08/26/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

22

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-92

Office Action Summary

Application No.

09/355,673

Applicant(s)

YAMANA ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 12, 14-27, 29-32 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-8, 12, 14-27, 29-32, 37 and 38 is/are allowed.
- 6) ☒ Claim(s) 34-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 34-36 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Misaizu et al (U.S. 5,068,295) as per reasons of record per paper no. 19, 02/07/03.**

Claim Rejections - 35 USC § 102

4. **Claims 34-36 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP'695 as per reasons of record per paper no. 19, 02/07/03.**

Allowable Subject Matter

5. **After further consideration, coupled with Counsel's persuasive arguments, the instantly claimed invention(2-8, 12, 14-27, 29-32, 37 & 38) is deemed allowable over the prior art of record, Misaizu et al, meritorious of the closest prior art, as per said art neither anticipating nor rendering obvious the meticulously defined film-forming auxiliary-governed composition, as claimed. One having ordinary skill in the art would not have been enabled with any motivation to extrapolate**

the specifically recited film-forming auxiliary(component (B))-gov rned composition containing copolymer (A) from Misaizu et al with any reasonable expectation of success.

Response to Arguments

6. *Applicant's arguments, see paper no. 20, filed 06/09/03, with respect to the rejection of claims 2-8, 12, 14-22, 25-27, 29-32 & 37 under 35 USC 102(b)/103(a) and 38 under 35 USC 103(a) over Misaizu et al have been fully considered and are persuasive. Therefore, the rejection of these claims over Misaizu et al has been withdrawn.*

7. *Applicant's arguments with respect to claims 34-36 filed 06/09/03 have been fully considered but they are not persuasive.*

Relative to Misaizu et al and JP'695----*The crux of Counsel's arguments appear to hinge on the failure of Misaizu et al and JP'695 to disclose or suggest any examples containing the combination of the repeating units (I), (II), (III), (IV) and/or (V) as defined by claim 2. Counsel is cordially directed to review cols. 2-5 of Misaizu et al and pages 3-5 of JP'695 wherein each of the monomer units (I)-(III) and (IV) and/or (V) are indeed taught. As to the examples not housing the claimed copolymer derived from repeating monomer units (I)-(III) and (IV) and/or (V), Counsel is herein reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in noway limited to the working Runs, i.e, the specification need not contain an example if the invention is otherwise disclosed in such a manner that one skilled in the art would be able to practice it without an undue amount of experimentation as provided for under the guise of In re Borkowski, 422 F 2d 904, 908, 164 USPQ 642, 645 (CCPA 1970).*

Conclusion

8. **THIS ACTION IS MADE FINAL.** *Applicant is reminded of th extension of time policy as set forth in 37 CFR 1.136(a).*

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
8.25.03